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EXAMINER

ZECHER, MICHAEL R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,861	<b>Applicant(s)</b> FICERY ET AL.	
	<b>Examiner</b> MICHAEL R. ZECHER	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The following is a first, non-final Office Action on the merits following a Request for Continued Examination entered October 14, 2008. **Claims 1-30** have been amended. **Claims 1-30** are pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claim 1** recites in the preamble “an electronic network system adapted to generate cost reduction strategies for a target company, the network system comprising.” The body of claim 1 recites various “tools” and “modules” in each limitation, including “a c cost lever analysis tool,” “a cost reduction strategy tool,” “a generation module,” “an implementation module,” and “an output module.” Claim 1 is considered non-statutory because the tools and modules are considered to be software, per se. Functional Descriptive material per se is not statutory. Functional Descriptive material in combination with an appropriate computer readable medium must be capable of producing a useful result when used in a computer system. Since the “tools” and “modules” lack storage on a medium and there are no instructions in executable form, no underlying functionality occurs and thus there is no practical application. For these reasons, claim 1 fails to satisfy one of the statutory categories set forth in 35 U.S.C. 101 and is therefore considered to be non-statutory.

**Claims 2-14** depend from claim 1 and are therefore rejected under the same rationale set forth above.

**Claim 1** fails to place the invention squarely within one statutory class of invention. In claim 1 of the present application, Applicant has provided evidence that applicant intends the “output” to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

**Claims 2-15** depend from claim 1 and are therefore rejected under the same rationale set forth above.

**Claim 16** fails to place the invention squarely within one statutory class of invention. In claim 16 of the present application, Applicant has provided evidence that applicant intends the “medium” to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

**Claims 17-30** depend from claim 16 and are therefore rejected under the same rationale set forth above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-2, 5-20, & 23-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Heyns et al. (U.S. 2004/0073467).

**As per claim 1**, Heyns et al. teaches an electronic network system adapted to generate cost reduction strategies for a target company, said network system comprising:

a cost lever analysis tool that (1) receives financial data inputs regarding the target company (2) calculates normalized diagnostic information regarding the cost structure of the target company based on financial data inputs, (3) displays the normalized diagnostic information, (4) receives cost levers based on the normalized diagnostic information, and (5) transmits the cost levers (See paragraph 53, which discusses a Value Management Financial Analysis Tool (VMFAT) that provides fast financial comparative analysis for a target company);

a cost reduction strategy tool that receives the cost levers (See paragraph 68, which discusses a Value Strategy Impact Model Tool (VSIMT) that allows a user to see the impact on future cash flows of specific operating strategies).

However, Heyns et al. does not disclose:

a generation module that generates a cost reduction strategy for one or more of the cost levers;

a linking module that correlates the cost reduction strategy with corresponding ones of the cost levers; and

an implementation module that generates implementation information related to implementing the cost reduction strategy; and

an output module that outputs signals representing the cost reduction strategy and the implementation information.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Heyns et al. to include various modules associated with cost reduction strategies for one or more cost levers, such as a generation module, a linking module, an implementation module, and an output module. Such a modification would have helped maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

**As per claim 2**, Heyns et al. teaches wherein said the implementation information includes at least one of case studies, implementation plans, integration implications, and sample benefit and impact forecasts (See paragraph 12 & 53, which discusses perpetual planning, forecasting, comparing the results to industry and/or sector average, etc.).

**As per claim 5**, Heyns et al. teaches wherein a plurality of case studies are correlated with each cost reduction strategy (See paragraph 53, which discusses how

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financial comparative analysis for a target company can be displayed using key metrics, including a selected number of different companies, results over a number of years, industry and/or sector average, etc.).

**As per claim 6**, Heyns et al. teaches wherein the implementation information includes case studies derived from more than one industry (See paragraph 53, which discusses how financial comparative analysis for a target company can be displayed using key metrics including industry and/or sector average).

**As per claim 7**, Heyns et al. teaches wherein the output module generates a cost-reduction strategy template for the target company (See paragraph 70, which discusses how a user selects a operating strategy).

**As per claim 8**, Heyns et al. teaches wherein the cost reduction strategy includes the implementation information (See paragraph 69, which discusses a list of operating strategies; and, furthermore, how business scenarios encompass most business decisions that focus on revenue improvement, cost reduction, and asset efficiency).

**As per claim 9**, Heyns et al. teaches wherein the implementation information includes at least one of economic impacts, strategy goal summaries, expected implementation schedules and plans, projected cost considerations, and projected key benefits (See paragraph 69, which discusses a list of operating strategies, including consolidating acquisition, non-consolidated acquisition, business divestiture, expansion, productivity improvement, revenue enhancement, cost reduction, changes in accounts

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receivable outstanding, accounts payable outstanding, inventory, trading position, and other strategies).

**As per claim 10**, Heyns et al. teaches wherein the cost lever analysis tool further comprises a calculation module that calculates a total return to shareholders using a calculated return on invested capital, a calculated weighted average cost of capital, a calculated organic growth, and a calculated merger and acquisition growth based on the financial input data (See paragraph 60, which discuss metrics including, capital weighted average cost of capital, NOPLAT growth, capital expenditure ratio, etc.).

**As per claim 11**, Heyns et al. teaches wherein the cost lever analysis tool generates summary reports, the summary reports including at least one of metrics or diagnostic ratios of the target company (See figures 5-9, which illustrate screen shots of graphs, tabular printouts, bar charts, etc. based on a metric or metrics selected by the user).

**As per claim 12**, Heyns et al. teaches wherein the summary reports include charts or diagrams comparing the metrics or the diagnostic ratios to baseline industry information (See figures 5-9, and paragraph 53, which illustrates and discusses financial comparative analysis for a target company correlated with classes of industry; and furthermore, screen shots of graphs, tabular printouts, bar charts, etc. based on a metric or metrics selected by the user).

**As per claim 13**, Heyns et al. teaches wherein the baseline industry information comprises metrics or diagnostic ratios pertaining to industry competitors of the target company (See paragraphs 53 & 58, which discusses financial comparative analysis for



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a target company correlated with classes of industry, and how to user can compare competitor companies side-by-side).

**As per claim 14**, Heyns et al. teaches wherein the summary reports include shareholder return graphs, the shareholder return graphs comparing a growth compound annual growth rate to a spread for the target company and industry peers of the target company (See figures 5-9, and paragraph 19, which illustrates and discusses shareholder value analysis; and, furthermore, screen shots of graphs, tabular printouts, bar charts, etc. based on a metric or metrics selected by the user).

**As per claim 15**, Heyns et al. teaches wherein at least one of the cost lever analysis tool, the cost reduction strategy tool, and the output module is located on server electronically accessible by remote users (See paragraph 61, which discusses how VMFAT operates on a SQL server database, and how a user may access the VMFAT over a secured network at various locations throughout the world).

**As per claim 16**, Heyns et al. teaches a computer-readable storage medium encoded with instructions which, when executed on a processor, perform a method comprising:

receiving financial data inputs regarding a target company (See paragraph 61, which discusses how the VMFAT receives financial data from FactSet Research Systems, Inc., on a daily basis);

calculating normalized diagnostic information regarding the cost structure of the target company based on the financial data inputs (See paragraph 64, which discusses

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calculating Market Value added, Economic Profit, NOPLAT, Capital Invested, and the Weighted Average Cost of Capital);

displaying the normalized diagnostic information (See figures 7-9 and paragraphs 53-57, which illustrates and discusses a Value Management Financial Analysis Tool (VMFAT) that provides fast financial comparative analysis for a target company); and

receiving cost levers of the target company based on the normalized diagnostic information (See paragraph 68, which discusses a Value Strategy Impact Model Tool (VSIMT) that allows a user to see the impact on future cash flows of specific operating strategies); and

However, Heyns et al. does not disclose:

correlating the cost reduction strategy with corresponding ones of the cost levers; generating implementation information related to implementing the cost reduction strategy; and

outputting signals representing the cost reduction strategy and the implementation information.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Heyns et al. to include a computer-readable storage medium with various applications capable of correlating cost reduction strategies and cost levers, generating implementation information, and outputting information concerning the cost reduction strategy and implementation information. Such a modification would have helped maintain benefits from economies of scale in addition to

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offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

**Claims 17-19** recite equivalent limitations to claims 7-9, respectively, and are therefore rejected using the same art and rationale as set forth above.

**Claims 20 & 23-24** recite equivalent limitations to claims 2 & 5-6, respectively, and are therefore rejected using the same art and rationale as set forth above.

**Claims 25-30** recite equivalent limitations to claims 10-15, respectively, and are therefore rejected using the same art and rationale as set forth above.

6. **Claims 3-4 & 21-22** are rejected under 35 U.S.C. 103(a) as being anticipated by Heyns et al. (U.S. 2004/0073467), further in view of Official Notice.

**As per claim 3**, Heyns et al. does not expressly disclose wherein said overviews comprise hyperlinked overview documents.

The Examiner takes Official Notice that it is old and well known in the art to provide hyperlinks for documents (See, e.g., claim 32 of Wallenius (U.S. 7,139,813) which discloses, teaches, and suggests hyperlinked and cross-linked documents). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heyns et al. to include hyperlinked overview documents that link different documents (See plain meaning of hyperlink...Webster's Dictionary).

**As per claim 4**, Heyns et al. does not expressly disclose wherein the documents can be cross-linked to each other.

The Examiner takes Official Notice that it is old and well known in the art to cross-link documents containing related subject matter (See, e.g., claim 32 of Wallenius

(U.S. 7,139,813) which discloses, teaches, and suggests hyperlinked and cross-linked documents). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heyns et al. to include cross-linking overview documents for related business capabilities in order to provide quick and efficient comparison of relevant strategic objectives via a links for different documents (See plain meaning of hyperlink...Webster's Dictionary).

**Claims 21-22** recite equivalent limitations to claims 3-4, respectively, and are therefore rejected using the same art and rationale as set forth above.

### ***Response to Arguments***

7. Applicant's arguments with respect to **claims 1-30** have been considered but are moot in view of the new grounds of rejection.

8. Regardless, Applicant's arguments filed October 14, 2008, have been fully considered but they are not persuasive.

In the Remarks, Applicant argues in substance:

(a) Heyns et al. fails to disclose, teach, or suggest a "generation module" or a "linking module" as recited in claims 1.

(b) In regards to Official Notice, Applicant asserts there is no motivation for one of ordinary skill in the art to modify the Heyns et al. to achieve the claimed combination of hyperlinked and cross-linked documents.

In response to (a):

The Examiner respectfully disagrees with Applicant's assertion. It is the Examiner's position that absent evidence of new or unexpected results, it is not

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inventive in terms of patentability to take one or more servers, in this case modules, which perform one or more tasks and add (or subtract) an additional number of modules to perform all or part of the same tasks by allocating the tasks between the various modules. The prior art is replete with examples showing why such scaling (both increasing and decreasing the number of modules) is desirable. See *e.g.* Chrabaszcz (U.S. 6,363,497).

In other words, a modification increasing the number of modules (*e.g.* having two modules perform a task previously performed by one server or tool) is analogous to making functions, structures, or actions separable. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable. See MPEP §2144.04 V. C. and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). As noted above, it is desirable to allocate the tools tasks to various modules to help reduce bandwidth bottlenecks and to help increase the benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion.

After careful review of the entire record, the Examiner finds that Applicants have not asserted any new or unexpected results regarding their hardware configuration (and the software running their hardware configuration) of their system and computer-readable storage medium. Therefore if the claimed network system, containing tools and modules, and the computer-readable storage medium were not directly disclosed, it

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would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Heyns et al. to include various modules or applications associated with cost reduction strategies for one or more cost levers, such as modules or applications that: (1) generate cost reduction strategies, (2) link respective strategies with cost-savings techniques, (3) provide implementation information for each respect strategy, and (4) output or transmit the strategy and implementation information. Such modifications would help maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

In response to (b):

The Examiner respectfully disagrees with Applicant's assertion. First, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Second, MPEP § 2144.03(C) provides the requirements to traverse an Official Notice: "Specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." [emphasis added]

Applicant has failed to adequately traverse official notice because applicant has only made a general allegation that the notice was not proper, in no way addressing why any of the facts would not be common knowledge. Indeed, with no guidance as to why those simple facts officially noticed are not well known, it is impossible to provide a

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reference addressing Applicant's potential concern. Therefore, according to MPEP § 2144.03(C), the officially noticed facts asserted in the previous office action are deemed admitted prior art.

Regardless, in furtherance of prosecution, Examiner has provided Applicant with a reference that discloses, teaches, and suggests hyperlinked and cross-linked documents (See, e.g., claim 32 of Wallenius (U.S. 7,139,813)). Additionally, attached to this correspondence is the plain meaning, according to Webster's Dictionary, of hyperlink; which directly correlates with why it is old and well known to one of ordinary skill in the art to modify Heyns et al. to include hyperlinked and cross-linked documents.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tang et al. (U.S. 6,988,092) discloses a method for evaluation of energy utilities.

Thomas et al. (U.S. 6,983,320) discloses a system, method and computer program product for analyzing e-commerce competition of an entity by utilizing predetermined entity-specific metrics and analyzed statistics from web pages.

Heyns et al. (U.S. 2004/0073442) discloses strategic planning and valuation.

Heyns. et al. (U.S. 2004/0073441) discloses planning for valve.

Olchanski et al. (U.S. 2003/0158749) discloses performance outcomes benchmarking.

White, Jr. (U.S. 6,088,676) discloses a system and method for testing prediction models and/or entities.

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Eden et al. (U.S. 2005/0171918) discloses a method and system of cost variance analysis.

Wallenius (U.S. 7,139,813) discloses time dependent hyperlink system in video content.

Kataoka (U.S. 2004/0186765) discloses a business profit improvement support system.

Buck (U.S. 2004/0030592) discloses business data analysis.

Block et al. (U.S. 2003/0172013) discloses a business analysis tool.

Sarno (U.S. 2002/0042751) discloses systems and methods for business to business financial analysis.

Chrabaszcz (U.S. 6,363,497) discloses a system for clustering software applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. ZECHER whose telephone number is (571)270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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